UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/505,594	02/16/2000	Jay Paul Drummond	D-1120-R1	5969

28995 7590 03/10/2009

RALPH E. JOCKE
walker & jocke LPA
231 SOUTH BROADWAY
MEDINA, OH 44256

EXAMINER	
SUBRAMANIAN, NARAYANSWAMY	
ART UNIT	PAPER NUMBER
3695	

MAIL DATE	DELIVERY MODE
03/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PAUL DRUMMOND, BOB CICHON,
MARK SMITH, DALE BLACKSON, DAVID WEIS,
JAMES R. CHURCH, and MIKAL R. GILGER

Appeal 2009-1123
Application 09/505,594
Technology Center 3600

Decided:[1] March 10, 2009

Before JENNIFER D. BAHR, MURRIEL E. CRAWFORD, and DAVID B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) (2002) from the final rejection of claims 1-11, 45, and 46. We reverse.

---

[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Representative claim 1 reads as follows:

> 1. An automated transaction machine comprising:
>
> a plurality of transaction function devices, wherein each transaction function device includes an associated device computer processor, wherein at least one device computer processor associated with a first transaction function device is operative responsive to being placed in operative connection with at least one other device computer processor associated with a second transaction function device, to cause the first transaction function device to become automatically interoperative with the second transaction function device;
>
> a data store in operative connection with both the first transaction function device and the second transaction function device, wherein the second transaction function device is operative to communicate a device driver from the second transaction function device to the data store for storage in the data store, wherein the first transaction function device is operative to access the device driver from the data store, wherein the device computer processor associated with the first transaction function device is operative responsive to the device driver to interact with the second transaction function device in carrying out a financial transaction with the automated transaction machine.

The reference set forth below is relied upon as evidence in support of the rejections:

Coutts	US 6,311,165 B1	Oct. 30, 2001

The Examiner rejected claims 1-11, 45, and 46 under 35 U.S.C. § 103(a) as unpatentable over Coutts. The dispositive issues are whether the

Appellants have shown that the Examiner erred in (1) taking Official Notice that the step where a transaction function device is operative to communicate a device driver from the transaction function device to the data store for storage in the data store is old and well known in the art; and (2) finding that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Coutts to include the step where a transaction function device is operative to communicate a device driver from the transaction function device to the data store for storage (or to the at least one other transaction function device, as called for in claim 10).

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

In the Final Office Action mailed August 10, 2004, the Examiner took Official Notice

> that the step wherein a transaction function device is operative to communicate a device driver from the transaction function device to the data store for storage in the data store is old and well known in the art. Communication of a device driver from the device to a data store helps in synchronization of transaction events making the process more efficient.

(Final Office Action 4). Appellants challenged the taking of Official Notice as unsupported by any evidence and argued that it constitutes "[a]n assertion of basic knowledge and common sense . . . not based on any evidence in the record [that] lacks substantial evidence support." (Br. 14).

The Examiner responded by producing an additional reference, listed in the "Evidence Relied Upon" section of the Answer as "JINI (TM) Device Architecture Specification, Sun Microsystems, Revision 1 (January 25, 1999) pp 1-14." (Answer dated December 22, 2005 at 3). The Examiner did not modify the original rejection to include the added reference, and reasserted the original rejection of claims 1-11, 45, and 46 as unpatentable over U.S. Patent Number 6,311,165 to Coutts et al. without change. He reiterated the contested taking of Official Notice (Answer dated December 12, 2005 at 4). It was not clear from the Examiner's Answer whether the Examiner intended to rely on the JINI (TM) Device Architecture Specification as an additional reference in support of the obviousness rejection or merely as evidentiary support for the earlier Official Notice, particularly in light of the Examiner's reference to "the cited reference in combination with the provided support for the official notice taken" (Answer dated December 22, 2005 at 9). We therefore remanded the case for clarification of whether the Examiner intended to enter a new ground of rejection over Coutts in view of the JINI (TM) Device Architecture Specification.

The Examiner also failed to respond to the Appellants' assertion that the JINI (TM) Device Architecture Specification does not qualify as prior art (Reply Br. dated February 17, 2006 at 7-8). In particular, the Appellants argued that

> nowhere in the present Answer does the Office even attempt to address, let alone establish, that the Sun Microsystems reference qualifies as prior art.
>
> The present application claims the benefit of U.S. Provisional Patent Application No. 60/120,506 filed February 17, 1999 pursuant to 35 U.S.C. [§] 119(e), and the rejected claims are fully supported by this provisional patent application. Although the Sun Microsystems reference includes a Revision 1.0 date which is purportedly January 25, 1999, neither the Sun Microsystems reference nor the Answer provide [sic, provides] any evidence whatsoever as to when the Sun Microsystems reference was actually completed or publicly available.

(Reply Br. dated February 17, 2006 at 8). The Examiner noted the filing of the Reply Brief, but deemed no further response necessary (Detailed Action mailed April 20, 2006). We therefore also remanded the case with instructions for the Examiner to clarify whether the JINI (TM) Device Architecture Specification qualifies as prior art (Remand at 4).

On remand, the Examiner mailed a new Answer on January 24, 2008, in which the Examiner clarified that the JINI (TM) Device Architecture Specification only is provided in support of the Official Notice taken and hence does not constitute new grounds of rejection (Answer dated January 24, 2008 at 9). With respect to the Appellants' challenge to the use of the JINI (TM) Device Architecture Specification as prior art, the Examiner found that

> The revision date of January 25, 1999 was the date when this document was made public. For instance the reference "It's out of the bottle – Sun introduces JINI™["] dated January 25, 1999

> discusses "Developers have been given early access to Jini connection technology for over six months. Jini technology is available today as shipping product On Sun's website at: http://www.sun.com/jini". Hence it is clear that this technology was available to the public at least on January 25, 1999. Hence the Sun Microsystems reference qualifies as prior art.

(Answer dated January 24, 2008 at 11).

Claim 1 requires that "the second transaction function device is operative to communicate a device driver from the second transaction function device to the data store for storage in the data store." The Appellants argue that the Examiner has not provided any prior art evidence to show that this limitation was known in the prior art (Reply Br. dated March 21, 2008 at 7-8). The Examiner concedes that Coutts does not teach the disputed limitation, but took Official Notice that the disputed step is old and well known in the art (Answer dated January 24, 2008 at 5). The Appellants continue to challenge the use of the JINI (TM) Device Architecture Specification as support for the taking of Official Notice. According to the Appellants:

> Further, the allegation in the present Answer that
>
> > the reference states that "Jini technology is available today as a shipping product" provides no evidence that the Sun Microsystems reference constitutes prior art to the present application. Later posted statements on a Sun Microsystems web site that "Developers have been given early access to Jini connection technology for over six months" does not provide any evidence that this specific Sun Microsystems reference was ever given to such developers. Even if the later

> statement was accurate, such access could have been given under a nondisclosure agreement or similar agreement which required the developers to keep the information regarding Jini technology, or any use of Jini, secret and non-public. Such secret, non-public use does not constitute prior art.

(Reply Br. dated March 21, 2008 at 7).

The Examiner has not explained how the statement that "Developers have been given early access to Jini connection technology for over six months. Jini technology is available today as shipping product On Sun's website at: http://www.sun.com/jini" proves that the JINI (TM) Device Architecture Specification was publicly available as of the revision date of the publication. It is not clear whether a software download was available or whether the particular documentation contained in the JINI (TM) Device Architecture Specification was available, and even if available, whether it was publicly available or only available with disclosure restrictions as suggested by Appellants. The Examiner thus has failed to show that the JINI (TM) Device Architecture Specification is prior art with respect to the present application on appeal.

The Appellant further argues that the Examiner has provided no valid reason or motivation to combine Coutts with the JINI (TM) Device Architecture Specification that the Examiner provided to support the taking of Official Notice (Reply Br. dated March 21, 2008 at 8). The Examiner found that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the claim limitation that a transaction function device is operative to communicate a device driver from the transaction function device to the data store for storage, because the

combination of teachings (apparently referring to the combination of the teachings of Coutts and the JINI (TM) Device Architecture Specification) taken as a whole suggests that the users of the device would have benefited from increased efficiency in processing the transaction (Answer dated January 24, 2008 at 5).

The Appellants argue that Coutts clearly argues the advantages and utility of downloading software modules from a remote server directly to peripheral devices. Specifically, Appellants argue that

> For example at Column 21, lines 22-27, Coutts states that: "Although the peripherals 364 are connected to the server 334 via the router 368, each peripheral 364 has independent access to the server 334 and is operable to download software modules directly therefrom (i.e.[,] software modules are not first downloaded to an intermediate location and then copied to the peripherals 64 from the intermediate location)". By stating that software modules are not downloaded to an intermediate location, Coutts expressly discourages one of ordinary skill in the art from considering modifications (such as the subject matter of claim 1) which is contrary to such a teaching.
>
> Also for example, Coutts specially teaches at Column 25, lines 5-12 that: "By having a direct connection from the peripherals 364 to the server 334 it is possible to allow the peripheral software applications to take a more active role in the overall operational flow of the ATM 362. This allows the user interface processor to concentrate on its primary tasks of providing user interface display graphics, animation and video facilities.

> The processing power required to operate individual peripherals 364 can then be selected to optimize the cost/performance ratio."

(Reply Br. dated March 21, 2008 at 9-10) (emphasis added). According to the Appellants, modifying Coutts to communicate device drivers in the opposite direction to that expressly taught by Coutts (as claimed by Appellants) would destroy the specific advantages and utility taught by Coutts.

We find that the Examiner has failed to present sufficient rational underpinning for the modification of Coutts to include the claim limitation that a transaction function device is operative to communicate a device driver from the transaction function device to the data store for storage. The Examiner's rationale, "[t]he combination of the teachings taken as a whole suggests that the users of the device would have benefited from increased efficiency in processing the transaction," (Answer dated January 24, 2008 at 5) is conclusory and does not explain why one of ordinary skill in the art would have found it obvious to modify Coutts, which teaches transferring device drivers directly from a server to peripherals, to communicate a device driver from the transaction function device to a data store for storage. Moreover, the Examiner provides no explanation for why such a modification would increase efficiency in processing the transaction. The Examiner thus has failed to establish a prima facie case of obviousness of claim 1 over Coutts. The Appellants thus have shown that the Examiner erred in rejecting claim 1 and claims 2-3, 6-9, and 46, which depend therefrom, as obvious over Coutts.

Claim 4 requires "wherein the device computer processor associated with the second transaction function device is operative to cause the driver to be stored in the data store." For the same reasons as described for claim 1 above, the Examiner has failed to make a prima facie case of obviousness of claim 4 over Coutts. The Appellants thus have shown that the Examiner erred in rejecting claim 4 and claim 5, which depends therefrom, as obvious over Coutts.

Claim 10 requires that "the first transaction function device is operative to communicate a device driver from the first transaction function device to the at least one other transaction function device." The Examiner found that Coutts teaches this limitation (Answer dated January 24, 2008 at 7-8, citing the discussion of claim 1 in the Answer and Coutts, col. 25, ll. 25-36). There is nothing in the discussion of claim 1 in the Answer that addresses communicating a driver from a first transaction function device to at least one other transaction function device, and the cited portion of Coutts describes downloading appropriate software modules by a media dispenser from a server without having to store every possible driver software module in the terminal housing the dispenser, not communicating a driver from one transaction function device to another. The Examiner thus has failed to establish a prima facie case of obviousness of claim 10 over Coutts. The Appellants thus have shown that the Examiner erred in rejecting claim 10 and claims 11 and 45, which depend therefrom, as obvious over Coutts.

The decision of the Examiner is reversed.

REVERSED

hh

RALPH E. JOCKE
Walker & Jocke LPA
231 SOUTH BROADWAY
MEDINA, OH 44256